

REMARKS

Applicants respectfully traverse the requiremnet for restriction.

Applicants submit that there is no burden in examining all the groups of claims together in this application. All of the claims relate to polypeptides that specifically interact with oncogenic forms of p53, or the specific SEQ ID NOs and polypeptides that possess this function. As stated in the M.P.E.P. at § 803:

If the search and examination of an entire application can be made without a serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Here, the Patent Office has not demonstrated that a burden exists. Applicants are unsure why the Patent Office states that the modes of operation or functions are different for the groups of claims identified (*see* page 6 of the Office Action, Paper No. 14). All the claims share the same functional interaction with oncogenic forms of p53. Furthermore, each sequence is related by this function - a function that is recited in the claims. The sequence structure is not the only consideration in determining if sequences are related. Finally, it would seem unlikely that a search encompassing the use of the polypeptides would exclude subject matter discussing the nucleic acids encoding these polypeptides, vectors for making them, and antibodies that detect them.

In addition, and without considering the merits of the PTO's conclusion on the relatedness of the sequences, applicants submit that the PTO's own rules for examination indicate that a burden in examining multiple nucleotide sequences does not exist. At M.P.E.P. § 803.04, the following text appears:

It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are

patentably indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together.

In some exceptional cases, the complex nature of the claimed material, for example a protein amino acid sequence reciting three-dimensional folds, may necessitate that the reasonable number of sequences to be selected be less than ten.

These rules clearly show and direct that at least ten different sequences can be and should be examined together. In this case, there are not even ten different SEQ ID NOs recited in the claims. Thus, according to the PTO, there can be no burden in searching all of the sequences of this application together. Any reasoning suggesting that restriction to a single sequence would appear to be improper and cannot be sustained. In the face of this clear indication that at least ten sequences should be examined together, the PTO has not shown why there is a burden in searching all the claims here. None of the reasons given for the restriction requirement implicate a serious burden.

Furthermore, the PTO has not addressed or provided any evidence or reasoning on the applicability of the "exceptional case" here. As noted in the rule quoted above, certain complexity requirements must be met for cases where the ten nucleotide examination rule is not employed. The PTO has not asserted that this case is exceptional or provided any evidence that it might be. Thus, applicants submit that the above-quoted rule applies to this application and the PTO should apply it in this application.


No extension of time fees or requests for extension of time, or any other fees or petitions, are believed to be necessary to enter and consider this paper. If, however, any petitions or extensions of time are required or any fees are due in order to enter or consider this paper or enter or consider any paper accompanying this paper, including fees for net addition of claims, or are required in order to keep this application pending, applicants hereby request any extensions

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or petitions necessary and the Commissioner is hereby authorized to charge Deposit Account No. 50-1129 for any fees.

Respectfully submitted,
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